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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,247	07/31/2008	Peter J. Sagona	62357.023706	6223

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EXAMINER
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GROSS, CARSON

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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08/31/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/599,247	<b>Applicant(s)</b> SAGONA ET AL.	
	<b>Examiner</b> CARSON GROSS	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7-9,11-13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9,11-13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/22/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/08/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1, 3-5, 7-9, 11-13, and 15-16 are pending as amended on 06/08/2010.  
Claims 2, 6, 10, and 14 are cancelled.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate both a supply roll (figure 1) and an active film (figure 2). Also, reference characters "3" and "4" have been used to designate a heating platen and an applicator head, respectively (figure 1). Reference characters "3" and "4" are also present in figure 2, but no explanation is provided as to what they are used to designate in figure 2. While figure 2 is unclear, it does not appear that reference characters "3" and "4" have been used to designate the same components in figure 2 as they do in figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 3-5, 7-9, 11-13, and 15-16 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-5, 7-9, 11-13, and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites a "non-sealing area" which is not clearly defined. The "non-seal area" is defined by its relationship to the seal between an active film and foil combination and a flexible package. Such a seal is not present in the instantly claimed method since there is no step of attaching an active film and foil combination to a flexible package. Furthermore, the claim is directed toward a method of attaching an active film onto a flexible package. There is no step in the claim in which such an attachment takes place. Lastly, the phrase "...is later attached to the flexible package..." is an intended use limitation that fails to limit the claimed method. For these reasons, one of ordinary skill in the art would not be clearly apprised of the scope of the invention. The only positively recited steps in claim 1 are heating a foil; applying an active film to the heated foil, wherein the active film comprises an active agent and a

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polymer; and applying pressure to the heated foil and active film combination so that the active film adheres to the foil. For examination purposes, the method will be limited to these positively recited steps.

7. Similarly, claim 9 recites a predetermined length which has a size that is defined by its relationship to the seal between an active film and foil combination and a flexible package. Again, such a seal is not present in the instantly claimed method since there is no step of attaching an active film and foil combination to a flexible package.

Furthermore, the claim is directed toward a method of attaching an active film onto a flexible package. There is no step in the claim in which such an attachment takes place. For these reasons, one of ordinary skill in the art would not be clearly apprised of the scope of the invention. The only positively recited steps in claim 1 are advancing a foil from a foil supply roll; advancing an active film from an active film supply roll, wherein the active film comprises two components and wherein the two components are an active agent and a polymer; cutting the active film into a pre-determined length; heating a foil; applying an active film to the heated foil; and applying pressure to the heated foil and active film combination so that the active film adheres to the foil. For examination purposes, the method will be limited to these positively recited steps.

8. Claims 3-5, 7-8, 11-13, and 15-16 are unclear because of their dependence on claims 1 and 9.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Neteler (US 6,531,197).

11. Neteler teaches a method of attaching an active film to a flexible package comprising the steps of: providing a foil (See col. 2, lines 9-16) and providing an active film comprising an active agent and a polymer (See col. 2, lines 1-5). The foil and active film are then attached to one another. They may be attached with an adhesive (See col. 3, lines 33-39) or, alternatively, the layers may be assembled together and subjected to an extrusion lamination process in which they are heated to effect bonding (See col. 3, lines 48-52). Extrusion lamination processes also involve the application of pressure to the layers being joined by passing the layers through a nip formed between two rolls. The active agent used is silica, which acts as an absorbing agent (See col. 3, lines 53-68).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) in view of Hekal (US 6,316,520; hereinafter referred to as '520).

16. Neteler teaches a method of attaching an active film to a flexible package, as detailed above.

17. Neteler does not expressly disclose the use of a releasing material in the active film.

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18. '520 teaches a method of attaching an active film onto a package. The active film comprises a releasing material and a polymer (See col. 4, lines 4-19; col. 6, lines 32-37). The active film is attached to a barrier sheet and used as a packaging wrap (See col. 8, lines 52-56).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the releasing agent disclosed by '520 with the method disclosed by Neteler. The rationale to do so would have been the motivation provided by the teaching of '520 that releasing materials can perform a great variety of useful functions in packages which require a controlled environment (See col. 5, lines 6-16). '520 teaches that one such function is to release a desiccating substance, which is important for packaging electronics (See col. 1, lines 54-57; col. 5, line 14).

20. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) in view of Hekal (US 6,177,183; hereinafter referred to as '183).

21. Neteler teaches a method of attaching an active film to a flexible package, as detailed above.

22. Neteler does not expressly disclose the use of an activation material in the active film.

23. '183 teaches a method of attaching an active film onto a package. The active film comprises an activation material and a polymer (See col. 4, lines 1-17; col. 6, lines 66-67; col. 7, lines 1-4). The active film is attached to a barrier sheet and used as a packaging wrap (See col. 9, lines 14-19).



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24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the activation material disclosed by '183 with the method disclosed by Neteler. The rationale to do so would have been the motivation provided by the teaching of '183 that activation materials can perform a great variety of useful functions in packages which require a controlled environment (See col. 5, lines 1-21). '183 teaches that one such function is to release a desiccating substance, which is important for packaging electronics (See col. 1, lines 53-56; col. 5, lines 18-19).

25. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) in view of Hekal (US 6,174,952; hereinafter referred to as '952).

26. Neteler teaches a method of attaching an active film to a flexible package, as detailed above.

27. Neteler does not expressly disclose the thickness of the active film.

28. '952 teaches a method of attaching an active film onto a package. The active film comprises an absorbing material and a polymer (See col. 4, lines 5-21; col. 6, lines 54-59). The active film is attached to a barrier sheet and used as a packaging wrap (See col. 9, lines 9-12). In one embodiment, the active film has a thickness of 4 mil, or about 0.1 mm (See example 1).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the active film of Neteler with the same thickness as the active film of '952. Both '952 and Neteler teach a an active film which comprises an absorbing material and a polymer, as detailed above. They both also teach that such

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an active film can be attached to a barrier layer which is useful in packaging for electronic components (See '952 col. 1, lines 55-58; Neteler col. 1, lines 15-20). Since both references teach an active film comprising an absorbing material and a polymer, and both teach that the active films are useful in the same process, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the active film in Neteler could have the same thickness the active film of '952.

30. Claims 9, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) in view of Mason (US 4,372,098).

31. Neteler teaches a method of attaching an active film to a flexible package, as detailed above.

32. Neteler does not expressly disclose advancing the foil and the active film from supply rolls and cutting the active film into a predetermined length prior to the attachment of the active film to the foil.

33. Mason teaches a process for attaching a pad to a foil. The foil and the pad are both advanced from supply rolls. The pad is cut to a pre-determined length and then heat sealed to the foil (See col. 4, lines 17-58).

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to advance the foil and active film of Neteler from supply rolls and to cut the active film into a desired size. It is conventional in the art to store films of various types in supply rolls and to advance multiple films from supply rolls in order to bring the films together to form a laminate. It is also conventional in the art to cut a

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laminate to a desired size. These processing steps are common knowledge in the art, and would be obvious to one of ordinary skill in the art.

35. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) and Mason (US 4,372,098), as applied to the claims above, and further in view of Hekal (US 6,316,520; hereinafter referred to as '520).

36. Neteler and Mason combine to teach a method of attaching an active film to a flexible package, as detailed above.

37. Neteler and Mason do not expressly disclose the use of a releasing material in the active film.

38. '520 teaches a method of attaching an active film onto a package. The active film comprises a releasing material and a polymer (See col. 4, lines 4-19; col. 6, lines 32-37). The active film is attached to a barrier sheet and used as a packaging wrap (See col. 8, lines 52-56).

39. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the releasing agent disclosed by '520 with the method disclosed by Neteler and Mason. The rationale to do so would have been the motivation provided by the teaching of '520 that releasing materials can perform a great variety of useful functions in packages which require a controlled environment (See col. 5, lines 6-16). '520 teaches that one such function is to release a desiccating substance, which is important for packaging electronics (See col. 1, lines 54-57; col. 5, line 14).

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40. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) and Mason (US 4,372,098), as applied to the claims above, and further in view of Hekal (US 6,177,183; hereinafter referred to as '183).

41. Neteler and Mason combine to teach a method of attaching an active film to a flexible package, as detailed above.

42. Neteler and Mason do not expressly disclose the use of an activation material in the active film.

43. '183 teaches a method of attaching an active film onto a package. The active film comprises an activation material and a polymer (See col. 4, lines 1-17; col. 6, lines 66-67; col. 7, lines 1-4). The active film is attached to a barrier sheet and used as a packaging wrap (See col. 9, lines 14-19).

44. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the activation material disclosed by '183 with the method disclosed by Neteler and Mason. The rationale to do so would have been the motivation provided by the teaching of '183 that activation materials can perform a great variety of useful functions in packages which require a controlled environment (See col. 5, lines 1-21). '183 teaches that one such function is to release a desiccating substance, which is important for packaging electronics (See col. 1, lines 53-56; col. 5, lines 18-19).

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45. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (US 6,531,197) and Mason (US 4,372,098), as applied to the claims above, and further in view of Hekal (US 6,174,952; hereinafter referred to as '952).

46. Neteler and Mason combine to teach a method of attaching an active film to a flexible package, as detailed above.

47. Neteler and Mason do not expressly disclose the thickness of the active film.

48. '952 teaches a method of attaching an active film onto a package. The active film comprises an absorbing material and a polymer (See col. 4, lines 5-21; col. 6, lines 54-59). The active film is attached to a barrier sheet and used as a packaging wrap (See col. 9, lines 9-12). In one embodiment, the active film has a thickness of 4 mil, or about 0.1 mm (See example 1).

49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the active film of Neteler with the same thickness as the active film of '952. Both '952 and Neteler teach a an active film which comprises an absorbing material and a polymer, as detailed above. They both also teach that such an active film can be attached to a barrier layer which is useful in packaging for electronic components (See '952 col. 1, lines 55-58; Neteler col. 1, lines 15-20). Since both references teach an active film comprising an absorbing material and a polymer, and both teach that the active films are useful in the same process, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the active film in Neteler could have the same thickness the active film of '952.

***Conclusion***

50. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARSON GROSS whose telephone number is (571)270-7657. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna WYROZEBSKI can be reached on (571)272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARSON GROSS/  
Examiner, Art Unit 1791

/KHANH NGUYEN/  
Primary Examiner, Art Unit 1791